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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,509	08/24/2001	Gregory P. Campau	1-23339	2340

46582 7590 08/30/2005

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604

EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,509

Applicant(s)

CAMPAU ET AL

Examiner

Christopher P. Schwartz

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20, 23-36, 39 and 41 is/are allowed.
- 6) ☒ Claim(s) 22, 36-38, 40 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

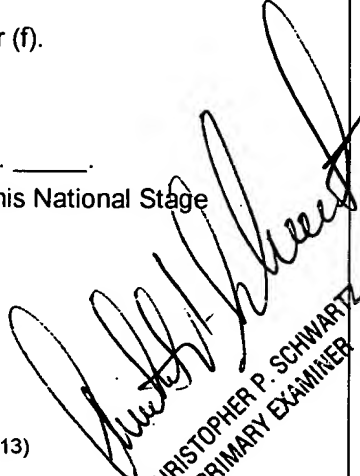
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/05 has been entered.

2. Claims 21-25,36-40 remain rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments, Inc.*, 59 USPQ 2d 1597 (Fed. Cir. 2001); *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003; *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the

application for the patent cannot be recaptured by the filing of the present reissue application.

With respect to applicant's remarks on page 18 of their response the examiner mistook claim 8 for an independent claim.

The test for recapture is outlined in section MPEP 1412.02. Applicant's are encouraged to review that section of the MPEP as it contains a more complete analysis than what the examiner outlined in the previous Office action. It appears applicant's are still confused over the proper test for recapture. See the three step test for recapture and the holding in Eggert, outlined on page 1400-18.

On page 15 of their arguments in the original file (08/813,146) applicant's repeated verbatim claim 1, as amended, in it's entirety. Specifically it was stated "Steiner et al. do not teach or suggest, alone or in combination with the references of record, at least the underlined structure recited in Claim 1 of the instant application".

Applicant's claimed in independent claim 1 in the original application " a valve for selectively preventing the flow of hydraulic brake fluid between the backup source and said vehicle brake;..." This valve also is part of the underlined structure at the end of claim 1. It is therefore a "key" limitation. Because it does not appear in claim 22 this claim is rejected under the recapture doctrine.

Because claims 36,37,38,40,42 are also all independent claims that are different versions of independent claim 1, and omit these key limitations, in one form or another (the examiner is not going to go through and list them all because they should be fairly

obvious) they too are rejected as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 22,36-38,40,42-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner '713 in view of Steiner et al '730 or Steiner '814.

Regarding claims 22,36-38,40,42-47 Steiner '713 shows a normal hydraulic energy source at 77. Note the operation of the normally open valves 48,49 as discussed at the bottom of column 3 and the fluid separator devices at 24 and/or 26. As broadly claimed by applicant the "back up" source to an ABS/TRC operation could in

fact be the master cylinder should the pump fail. Note the fluid conduits coming off of the master cylinder which can be interpreted as the first and second backup conduits

Steiner lacks a specific disclosure of the first and second sensors as now claimed.

Steiner et al. '730 or Steiner '814 show similar types of sensors to that of applicant's that are known in the art. See Steiner '730 elements 71,74,76 and Steiner '814 at 59, 61.

It would have been obvious to the ordinary skilled worker in the art at the time of the invention to have used a sensor arrangement, as taught by either of the Steiner references in the device of Steiner '713 to better control the pedal feel characteristics by the vehicle operator during heavy braking.

The limitations of the remaining claims listed above are taught by the combined structural features of the references above.

Response to Arguments

6. Applicant's arguments with respect to claims 22,36-38,40,42-47 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

7. Claims 1-20,23-35,39,41 are allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record has been cited for showing related concepts.

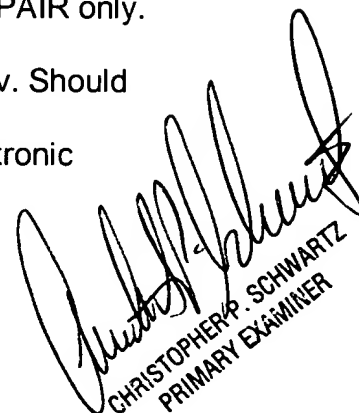
However it is recommended applicant's review all of the prior art of record since all of the limitations in at least some of the claims are taught by several patents in the prior art of record.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 571-272-7123. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cps
8/25/05



CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER